

### **REMARKS**

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Thayer** et al (6,131,209) in view of **Beames** (D 466, 543).

Thayer discloses eyewear having solid frame 60 having a lens; frame 60 consists of one piece solid molded frame; said frames having a nose bridge which fits on top of a user's nose; said frames secured around the user's head by a single band 52; said band 52 secured to said frames 60 by two securing pieces wherein said band 52 is removed from the frame by either or both of said securing pieces; wherein Velcro is used for both securing pieces; wherein said band 52 can be totally removed from said frames and replaced with other similar bands. (see Fig. 5).

Thayer teaches a single lens in the frame and does not teach a pair of lenses as claimed by applicant.

Beames, discloses the frames having a pair of lenses. Because Thayer and Beames are both from the same field of endeavor, the purpose of aesthetic feature as disclosed by Beames would have been recognized as a pertinent art of Thayer.

It would have been obvious to construct the eyeglass frame such as the one disclosed by Thayer, with a pair of lenses, such as disclosed by Beames for the purpose of aesthetic feature.

**Applicant has amended the claims to state that the band is removed from the frame by removing both securing pieces of the band**

**from the frame. Neither Thayer nor Beames alone or in combination teach the complete removal of the band from the frame. Beames specifically shows only one removable section and therefore cannot teach removal of the whole band. Thayer also only shows one removable section and not that the band can be removed totally from the frames.**

The Examiner states that applicant argued that nowhere does Thayer state that band 52 is replaceable or is placed by other band. Although does not explicitly state that the band 52 can be replaced by other band as claimed by applicant, one end 56 of the band 52 releasable attached to the eyewear by passing through the slot 62, thus the band 52 can be replaceable or substitute by other band (fig. 5 and col. 5, lines 1-16).

**As shown in this section, only one side of the band is shown being removed from the frame and not both bands. Therefore, the combination of Thayer and Beames does not teach what is claimed in the amended claims.**

The Examiner states that applicant argued that Thayer teaches a cleaning apparatus for goggles. The apparatus of Thayer requires a compartment 54 having a cleaning cloth contained therein. Since the claims have consisting of language, the combination of Thayer and Beames cannot make obvious applicant's claims.

Applicant points to section 211.03 which relates to transition phrases including "comprising" and "consisting of". This section specifically states that the transition phrase "consisting of" excludes any element, step or ingredient, not specified in the claim.

Based on the MPEP and the case law cited above, because Thayer requires a compartment containing a cleaning cloth, it cannot make obvious with Beames the claims of the present invention.

The Examiner states that the above argument is not persuasive, because applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claim present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references objections.

**Applicant has shown previously that Thayer requires a compartment containing a cleaning cloth. Therefore according to the MPEP and the case law previously suggested, it cannot anticipate or make obvious the claims. The Examiner's pointing to the section of 37 CFR is incorrect. Applicant has shown that it is the elements of the claim with consisting of language which is not taught by either piece of the prior art, i.e., the references cited or the objections made. The Examiner has the burden to show why the prior art references would still apply even though they have other elements which go beyond the**

**consisting of language. The language has failed to address this point.**

**For all of the above reasons, applicant believes the claims are allowable over the prior art.**

Claims 13-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sadowsky (5,042,094).

Sadowsky discloses eyewear with prosthetic parts for small children comprises frame (30) for holding two lenses (20), the frame (the frame 30 is constructed with resilient material, preferably also soft and pliable see column 3, lines 21 and 22) secured to a head by a band (40), said band (40) is secured to the frames by two securing pieces (42) including Velcro is used for both securing pieces and the band (40) can be totally removed from the frame and replaced with other similar band (see figure 1 and the related disclosure.) Note that solid frame means the frame having interior completely filled up and free from cavity, or not hollow.

The Examiner states that applicant argued that nowhere does Sadowsky teach colored lenses. This argument is not persuasive because Sadowsky clearly states that it provides a new and improved type of sunglasses for babies (col. 1, lines 6-10). See definition of sunglasses in applicant's prior remarks. Therefore, the claimed invention does not distinguish over the Sadowsky device.

The Examiner states that applicant argued that the Examiner states that other similar bands can be replaced with a band. Nowhere is that taught in

Sadowsky. It only shows that the same band can be opened to be removed from a child's head, but not replaced with a further band.

The Examiner states that applicant argued that Sadowsky does not teach that other similar bands can be replaced with a band. It only shows that the same band can be opened to be removed from a child's head, but not replaced with a further band. Although Sadowsky does not explicitly state that the band can be replaced by other bands, the band is releasably attached to the eyewear, thus the band could be replaceable or substituted by other band. Therefore, the claimed invention does not distinguish over Sadowsky.

**Applicant's claim states not that the band can be replaced by other bands, but that the band "is" replaced by other bands. Since Sadowsky does not show any other bands, it does not teach that the bands is replaced by other bands.**

Applicant argued that the "consisting of" language gets around Sadowsky. Based on the MPEP and the case law cited, because Sadowsky requires the prosthetic pieces, it cannot anticipate the claims of the present invention.

The Examiner states that the argument is not persuasive because applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or rejections.

**Applicant has previously stated that its glasses do not need the prosthetic pieces that are shown by Sadowsky and can function without them for use with baby and toddler sunglasses. This is what makes its glasses novel. Since Sadowsky requires these prosthetic pieces and the claims of the present invention have consisting of language, Sadowsky cannot make obvious or anticipate the claims of the present invention.**

The Examiner has rejected Claims 13-15 as being obvious over Laschober.

Laschober discloses eyeglasses with releasable headband support arrangement comprising one piece solid molded frame (14) for holding two lenses (16), the frame (14) having a nose bridge (18) which fits on top of the user's nose, the frame (14) secured to a head by a band (28), said band (28) secured to the frames by two securing pieces (30), wherein the band (28), is removed from the frame by either or both of the securing means (Figs. 1-4). Laschober discloses the attachment members are easily attachable to and attachable from the connector members of the frames and the headband is easily attachable to and detachable from the attachment members. This allows the wearer to alternate and mix and match headbands and attachment members of different colors, patterns, or other motifs (col. 3, lines 47-60).

Laschober does not explicitly state the lenses are colored as claimed by applicant. However, lenses are tinted or colored are well known in the art for the purpose of preventing harmful radiation from reaching the wearer's eye. It

would have been obvious to make the lenses of Laschober, tinted or colored for the purpose of preventing harmful radiation from reaching the wearer's eye. Sadowsky teaches a new and improved type of sunglasses for babies (col. 1, lines 6-10). The definition of sunglasses is eyeglasses with colored or tinted lenses that protect the eyes from the glare of sunlight.

The Examiner states that applicant argued that Laschober requires an attachment member adapted for the releasable securement of a connective member. Since the claims require (consisting of) language, Laschober cannot anticipate or make obvious the claims. The Examiner has stated that Laschober teaches every feature of the claimed device, however, the Examiner has not stated that Laschober also teaches further elements that are required which make Laschober not able to anticipate or make obvious the claims of the present invention.

Applicant points to Section 211.03 which relates to transition phrases including (comprising) (consisting of). Based on the MPEP and the case law cited above, because Laschober requires the attachment member, it cannot anticipate or make obvious the claims of the present invention.

The Examiner states that this argument is not persuasive because applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out that patentable novelty the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

**The Examiner's own statements citing col. 3, lines 47-60 which state that attachment members are attached to members, and not directly to the frame, support applicant's argument. Applicant's claims state that the securing members are attached to the frame. Since the claims use consisting of language and the prior art teaches other elements not inclusive in the claims, the claims cannot be anticipated by Laschober. The fact that the claims do not teach connector elements is what makes the invention patentable over the prior art.**

Applicant believes the application is in condition for allowance.

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